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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,113	11/05/1999	MAX P. MCDANIEL	33815US	4779

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-18

Office Action Summary

Application No.
09/435,113

Applicant(s)
McDaniel et al.

Examiner
J. Pasterczyk

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-47, 61, and 62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-47, 61, and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. This Office action is in response to the amendments filed with the RCE of 8/8/03 and refers to the Office action mailed 10/16/01.

2. Claim 62 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 62 recites the negative limitation of the chromium catalyst being “substantially free of fluorine”. This limitation is not found affirmatively recited anywhere in the specification, and hence is new matter under Ex parte Grasselli, 231 USPQ 393.

3. Claims 30-47, 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, first and third lines of b), insert --the group consisting of-- after “selected from” for clear closed Markush language; in the last line change “or” back to --and--. These errors also exist in claim 46, along with in the penultimate line “or” should be --and--.

In claims 61 and 62, 1. 1 and 2 of b) of each, insert --the group consisting of-- after “selected from”; in the third line of b) of each claim, change “or” to --and--.

In claim 39, 1. 3, insert --the group consisting of-- after “selected from”, and in the penultimate line change “or” to --and--, again for proper closed Markush language.

In claims 40, 42 and 44, “said alkyl compound” strictly lacks antecedent basis since a group of alkyl compounds is recited in the superior claims.

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In claim 47, last line, delete "a" since triethylaluminum is itself a compound.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 30-45, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debras in view of Konrad or Witt as cited in and for the reasons of record given in paragraph 6 of the previous Office action cited above.

6. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debras in view of Konrad or Witt as cited above, and further in view of Benham as cited in and for the reasons of record given in paragraph 7 of the Office action cited above.

7. Applicant's arguments filed 8/8/03 have been fully considered but they are not persuasive.


Applicants' main argument is that Debras is limited to a fluorine-containing catalyst. However, as noted above, applicants' attempt to overcome this limitation by reciting a negative limitation of no fluorine being in the catalyst is unavailing as it is new matter. Furthermore, the present claims 30, 46, and 61 are drafted in open Markush language with respect to the combination of reagents which may be added, hence the presence of fluorine is not prohibited.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

AU 1755

8/27/03